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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,703	01/26/2000	Alex Dai-Shun Poon	2043.007US1	8953
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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				EXAMINER MALHOTRA, SANJEEV
		ART UNIT 3667		
		PAPER NUMBER ELECTRONIC		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/491,703	Applicant(s) POON, ALEX DAI-SHUN
	Examiner SANJEEV MALHOTRA	Art Unit 3667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 May 2012.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) Claim(s) 9,14-16,25,30-32,41,46-48,71,73 and 75 is/are pending in the application.
- 5a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 6) Claim(s) _____ is/are allowed.
- 7) Claim(s) 9,14-16,25,30-32,41,46-48,71,73 and 75 is/are rejected.
- 8) Claim(s) _____ is/are objected to.
- 9) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1448)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Status of Claims

1. Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 are pending per remarks and claim amendments filed by the Applicant on 05/04/2012, wherein Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 have been amended, and Claims 1-8, 10-13, 17-24, 26-29, 33-40, 42-45, 49-70, 72, 74 and 76 have been cancelled.

This Office Action is a final rejection per the remarks and 'amendments to the claims' filed on May 04, 2012 by the Applicant for its original application filed on 26 January, 2000 that is titled: "Method and Apparatus for Facilitating User Selection of a Category Item in a Transaction".

Accordingly, amended Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 are now being examined in this Office Action.

Claim Objections

2. Claims 9 and 75 are objected to because of the following informalities:

- Lines 4-5 of amended independent Claim 9 recites the limitation "said plurality of category entries being being indicative of a categorization of", which has word "being" recited in duplicate that is wrong English. Examiner has read this claim to have only word "being" recited herein for this examination.

- Line 5 of amended Claim 75 recites the limitation "in said display window.." with two periods at the end, which is incorrect English. Examiner has read this claim to have only period recited herein for this examination.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 9, 14, 15, 25, 30, 31, 41, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,397,221 issued to Greef et al. (hereinafter

"Greef") in view of the Official Notice taken by the Examiner for a transaction to take place.

With respect to Claims 9, 25 and 41: Greef discloses, Providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction (col.7, line 35) (**Greef discloses "As also noted, Web site sales facilities** (e-commerce) are commonly built upon computer-based catalogs, which are themselves built upon product databases containing records concerning the items being offered, the term "product" embracing goods and or services. Accordingly, before any **transaction** of commercial interest can occur, Web **shoppers** must first search through such product databases in the hope of finding something of interest. Regrettably, however, at many Web sites, **shoppers** have to plow through stacks of menus and product information listings to find, if at all, things they might be looking for." (col.7, 31-37). (col. 15, lines 34-52); detecting a selection of a category entry of said plurality of category entries in said display window (col. 15, lines 53-65); in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items (**Greef discloses "As an alternative to relational databases, however, it has been found that even** **shoppers** having different product familiarity and backgrounds are commonly able to easily and quickly extract desired product information from

database that are hierarchically arranged and presented. As an illustration, where a shopper is looking for specialty apples; for example, from a gourmet site, he can more readily make progress with his selection if he looks first at foods, then fruits, and then apples as he progress to his selection. At the least, the approach of moving from generally understood category to subcategory and sub-subcategory avoids the risk of causing the uninitiated shopper to mistakenly compare apples and oranges when trying to make his purchase selection. (Greel: col.2, 61-67 and col.3, 1-6)). Here, there is "responding to said detection of said selection of said category" by having the selected product extracted from the selectable list of products. Furthermore, there clearly is "at least one subcategory field within said display window" and "plurality of subcategory entries being used to categorize said item in said transaction") Greel (col.2, 61-67 and col.3, 1-6) (col. 7, lines 31-44, col. 29, line 40-col. 30, line 60 and col. 31, lines 18-59);

Detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window (col.29, 8-24; col.30, 26-41; col.31, 17-50; fig's 8-14) Receiving a specification of a category number (model number) that uniquely identifies a combination of said category entry and said subcategory entry (presentation format). (Greel clearly discloses category number (model number) to be displayed for user in display window (presentation formats). Greel discloses "In preferred form, the record identifier could be selected to be, for example, the tabular attribute model number, the model number, for the product being an

identifier likely to receive recognition across presentation formats." (col.18, lines 42-46)), (col.27, 44-59, col.2, 61-67, col.3, 1-6), (col.29, 50-67; col.30, 1-14 and 25-42; col.31, 18-50). Greef discloses mapping specification as in --- "the mapping specification should be saved for use in importing tabular product data to the database in the future. If the user indicates the mapping specification is to be saved, the method enables program flow to advance over branch 272 to general step 118 for saving the mapping data." (col.20, L24-52; col.28, L26-42)

receiving an additional specification of said category number; and based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window (col.29, 8-24; col.30, 26-41; col.31, 17-50; fig's 8-14; col.11, 47-57; col.5, 16-32). Greef discloses attribute values and "other attributes" that are same as claimed 'additional specification' as in --- "in view of the inclusion in table 400 of the various other attributes for the respective products in combination with the respective category and subcategory attributes, the data also includes sufficient information from which it might also be possible to establish the respective frame attributes and attribute values for the product frames of the hierarchical structure without intervention of the user." (col. 28, L54 to col. 29, L24). However, Greef might not expressly disclose a transaction, since this is an e-commerce shopping system and method, a transaction is obviously present. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction take place per the Official Notice in view of Greef's teachings of an e-commerce shopping method and system and to modify in Greef

because such a modification would allow Greef to have items to select from, prior to making a transaction.

With respect to Claims 14, 30 and 46: Greef discloses, wherein said plurality of category fields are to be displayed in a first portion of said display window and said plurality of subcategory fields are to be displayed in a second portion of said display window (col. 10, line 31-col. 11, line 46).

With respect to Claims 15, 31 and 47: Greef discloses, wherein said first portion of said display window is substantially adjacent to said second portion of said display window (Figure 5).

5. Claims 16, 32, 48, 71, 73, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,397,221 issued to Greef et al. (hereinafter "Greef") in view of Pub. No. US 2005/ 0071251A1 filed by Linden et al. (hereinafter "Linden").

With respect to Claims 16, 32 and 48: Greef failed to disclose wherein said first portion of said display window is a category field that corresponds to a page mark-up language document. Examiner notes that HTML is old and well known in the art of the internet and reference can be made to page 3, col. 1 [0035] to Linden et al. (US 2005/ 0071251A1).

With respect to Claims 71, 73 and 75: Greef discloses, wherein said plurality of category entries and said plurality of subcategory entries are to be concurrently in said

display window. (col. 8, lines 26-53 and col. 29, line 39-col. 30, line 59). Examiner notes that Linden also teaches about category and subcategories.

Response to Arguments

6. Applicant's remarks and arguments dated May 04, 2012 with respect to the rejection of amended Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 have been carefully considered, but they are not persuasive. Thus, the rejection of amended Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 under 35 USC 103(a) is being maintained with some modifications in this Office Action, where needed to provide clarification. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Examiner notes that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Applicant is informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply.

In response to the Applicant's 'amendments to the claims' and arguments against 35 USC 103 rejection, Examiner notes that when combining references for rejection under 35 USC 103, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it

that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to the Applicant's arguments on pages 9-11 filed on 05/04/2012, Examiner notes that Greef discloses, in addition to what has been previously cited, as follows ---

Greef teaches mapping specification as in --- "the mapping specification should be saved for use in importing tabular product data to the database in the future. If the user indicates the mapping specification is to be saved, the method enables program flow to advance over branch 272 to general step 118 for saving the mapping data." (col.20, L24-52; col.28, L26-42)

Greef teaches attribute values and "other attributes" that are same as claimed 'additional specification' as in --- "in view of the inclusion in table 400 of the various other attributes for the respective products in combination with the respective category and subcategory attributes, the data also includes sufficient information from which it might also be possible to establish the respective frame attributes and attribute values for the product frames of the hierarchical structure without intervention of the user." (col. 28, L54 to col. 29, L24).

Examiner notes that in *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1149, 219 USPQ 857, 860 (Fed.Cir.1983), it states --- 'where teachings relied upon to show obviousness were repeated in a number of references, the conclusion of obviousness

was strengthened', and some of the limitations are taught in both references Gref and Linden as cited above in the 35 USC 103(a) rejection section.

Examiner had cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, these are minimum citations and other passages and figures may apply as well, and the Applicant is advised to consider a reference in its entirety for its teachings as applied to the rejection of claims. It is therefore respectfully requested from the Applicant/s, in preparing their responses, to fully consider all the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Examiner notes a few typographical errors in the Applicant's Remarks of 05/04/2012 as follows (and requests clarification) ---

- On page 8, second paragraph, cancelled claims should have stated "72, 74 & 76" and not "72, 72, & 76" as is now done in second line of that paragraph.
- On page 11, fourth paragraph, it states in error as --- "Applicants respectfully request that the Examiner withdraws the rejection of claims 9, 11-15, 25, 27-31, 41 and 43-47 under 35 U.S.C. § 103(a).", and Examiner notes that per the Remarks on top of page 8, it clearly states that many of claims, such as 10-13, 17-24, 26-29, etc., have been cancelled as stated therein --- "claims 1-8, 10-13, 17-24, 26-29, 33-40, 42-45, 49-70, 72, (74), & 76 are cancelled, and no claims

are added;”, and Examiner notes that since many of the claims have already been cancelled by the Applicant in its ‘amendments to the claims’ filed on 05/04/2012, said request to withdraw rejection of such cancelled claims is moot.

- On page 11, fifth paragraph, it states in error as --- “Applicants respectfully request that the Examiner withdraws the rejection of claims 16, 32, 48, 58, 59, 62, 63, 66, 67, 71, 73 and 75 under 35 U.S.C. § 103(a).”, and Examiner notes again that since many of these claims have already been cancelled by the Applicant in its ‘amendments to the claims’ filed on 05/04/2012 (such as 49-70 are now cancelled), said request to withdraw rejection of such cancelled claims is moot.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon, and listed in Form 892, that is considered pertinent to the Applicant's disclosure and review for not traversing already issued patents and/or claimed inventions by the claims of this invention of the Applicant.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SM/
23 JUNE, 2012

/Mary Cheung/
Primary Examiner, Art Unit 3667